

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

CIRBA INC. (d/b/a DENSIFY)
and CIRBA IP, INC.,

Plaintiffs/Counter-Defendants,

v.

VMWARE, INC.,

Defendant/Counter-Plaintiff.

C.A. No. 19-742-GBW

(Consolidated)

**STIPULATION AND [PROPOSED] ORDER TO SEVER AND STAY
CLAIMS RELATED TO '492 AND '459 PATENTS**

WHEREAS, Cirba Inc. and Cirba IP, Inc. (collectively “Densify”) asserted counterclaims for infringement of U.S. Patent Nos. 10,523,492 (“’492 patent”) and 10,951,459 (“’459 patent”) against VMware (D.I. 992), and VMware asserts defenses related to the ’492 and ’459 patents (D.I. 1009);

WHEREAS, VMware disputes that Cirba Inc. has standing and that Cirba IP, Inc. was properly joined as a counterclaim plaintiff as to the ’492 patent (D.I. 1431);

WHEREAS, VMware filed an IPR petition against the ’492 patent (C.A. No. 20-272, D.I. 95) and a PGR petition against the ’459 patent (D.I. 1021);

WHEREAS, the Patent Trial and Appeal Board issued a final written decision finding all claims of the ’492 patent invalid on May 7, 2022 (D.I. 1254), and denied Densify’s request for Director Review of the final written decision on November 29, 2022 (D.I. 1493);

WHEREAS, the Patent Trial and Appeal Board issued a final written decision finding all claims of the ’459 patent invalid on December 7, 2022 (D.I. 1495);

WHEREAS, Densify intends to appeal the Patent Trial and Appeal Board’s final written decisions related to both the ’492 and ’459 patents;

WHEREAS, the parties desire to preserve their and the Court's resources pending any appeals;

NOW, THEREFORE, IT IS HEREBY STIPULATED AND AGREED by and between the parties, through their undersigned counsel and subject to the approval of the Court, that Densify's counterclaims as to the '492 and '459 patents, and all defenses thereto, are hereby severed from this action into a separate case, and that case is stayed pending resolution of Densify's appeals related to the Patent Trial and Appeal Board's Final Written Decisions related to the '492 and '459 patent. The Court may decide not to address the parties' pending motions related solely to the '492 and '459 patents at this time: D.I. 1434 (Densify's motion for summary judgment of no inequitable conduct); D.I. 1431 (VMware's motion to dismiss '492 patent counterclaim); D.I. 1433 (VMware's motion for judgment on the pleadings, as to the '459 patent only).

Dated: January 3, 2023

FARNAN LLP

/s/ Michael J. Farnan

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Respectfully submitted,

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IT IS SO ORDERED this _____ day of _____, 2023.

United States District Judge